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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/476,711   | 12/30/1999  | DAVID O. MCGOVERAN   |                     | 8198             |
| 7590   | 05/29/2008  |                      | EXAMINER            |                  |
| GEORGE S COLE<br>495 SEAPORT COURT SUITE 101<br>REDWOOD CITY, CA 94063 |             |                      | BOYCE, ANDRE D      |                  |
|  |             | ART UNIT             | PAPER NUMBER        |                  |
|  |             | 3623                 |                     |                  |
|  |             |                      | MAIL DATE           | DELIVERY MODE    |
|  |             |                      | 05/29/2008          | PAPER            |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/476,711             | MCGOVERAN, DAVID O. |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Andre Boyce            | 3623                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 January 2008.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 112-190 and 192 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 112-190 and 192 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on February 19, 2007 and January 23, 2008 have been entered.
  
2. Claims 112, 114, 117, 118, 120-125, 130-137, 140, 142, 144, 145, 148, 157-159, 161, 164-166, 177-184, 186, 188 and 192 have been amended. Claims 112-190 and 192 are pending.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 112-190 and 192 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Here, the result of the invention lacks concreteness,

since the result is not assured and reproducible, as discussed below. As such, the invention cannot be used as intended without undue experimentation, and is therefore not enabled.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 112-190 and 192 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In order to be considered useful, the claimed invention must possess a specific, substantial, and credible utility. In order to be concrete, the result must be assured and reproducible. In order to be tangible, the invention must provide a real world result and must involve more than a manipulation of an abstract idea.

In the present case, independent claims 112 and 192 provide no concrete result. Claim 112 recites declaring and stating an objective, declaring and stating at least one objective rule set, delegating to at least one specific set of actors, determining the satisfaction of a rule's condition, modifying at least one element, etc. However, the claimed invention is merely a "reasoning paradigm," (i.e., theoretical approach/roadmap) as described by Applicant, and produces no concrete result. Moreover, this reasoning paradigm (i.e., claimed invention) is subjective, whereby

the result is neither assured nor repeatable. Claims 113-190 are rejected based upon the same rationale. Claim 192 recites means for accepting, comparing, delegating, determining, modifying, etc. However, these limitations provide no concrete result, since the result cannot be assured or reproduced, as discussed above.

### ***Response to Arguments***

7. In the Remarks, Applicant argues that claim 112 is concrete because the result (i.e., the objective) is stated as a set of measurable goals and constraints and rules are also stated to accomplish at least a part of said objective by the combination of at least one subset of the rules. In addition, Applicant contends that the claimed invention can be used as intended without undue experimentation, because constraints and rules are specified during the process defined by the claim such that the result is concrete if the specified action is executed when the conditions and constraints are satisfied.

The Examiner submits that while the objective may be stated as a set of measurable goals and constraints, the claimed invention still lacks concreteness, because the "objective," although stated as a set of measurable goals and constraints, may not be assured, reproducible, and could be impossible. Here, the "objective" is very broad and can encompass seemingly anything, thus leading to a result that is neither assured nor reproducible, since the claim language does not describe, for example, how the objective is determined, who determines the

objective, what area of art the objective is related to, what the objective accomplishes, the context of the objective, etc.

As an example, someone intending to practice the invention could set an objective of "find a cure for every type of cancer in 3 months," and state that objective as a set of measurable goals and constraints, declare and state objective rule sets, delegate specific actors, etc., and still end up with a result that is neither assured nor reproducible, and likely impossible. As a result, the claimed invention indeed lacks concreteness and remains rejected under 35 USC § 112 and 35 USC § 101, because of the vagueness and broadness of the "objective."

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre Boyce whose telephone number is (571)272-6726. The examiner can normally be reached on 9:30-6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Van Doren can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andre Boyce/  
Primary Examiner, Art Unit 3623  
May 26, 2008